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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,709	12/02/2003	Teruaki Itoh	160-400 (AMK)	2216
23117	7590	10/10/2007	EXAMINER	
NIXON & VANDERHYE, PC			WRIGHT, PATRICIA KATHRYN	
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ARLINGTON, VA 22203			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/724,709	ITOH, TERUAKI	
	Examiner	Art Unit	
	P. Kathryn Wright	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 July 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 July 2007 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/30/2007</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Response filed July 30, 2007, in which claims 2 and 4 were canceled. Claims 1 and 3 are currently pending. Any objection/rejection not repeated herein has been withdrawn by the Office.

Information Disclosure Statement

2. The information disclosure statements filed May 04, 2005 and the duplicate filed July 30, 2007 fail to comply with 37 CFR 1.98(a)(3) because they do not include a concise explanation of the relevance of the JP- 07-35437 reference, which is not in the English language. The information disclosure statement should include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The aforementioned reference has been placed in the application file, but the information referred to therein has not been considered.

Applicant states in the Response, filed July 30, 2007, the IDS was filed along with a translation of an Office Action from a corresponding Japanese Patent Application, see page 7. Applicant asserts that the English language translation of the Office Action is available in PAIR. The Examiner cannot locate the English language translation of the Foreign Office Action in PAIR. It is hereby requested that Applicant submit concise explanation of the relevance of the JP- 07-35437 reference to the Office.

Drawings

3. The drawings were received on July 30, 2007. These drawings are accepted by the Examiner.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yuyama (US Patent no. 6,138,868) in view of Miner (US Patent no. 488,084).

Yuyama teaches an automatic tube-type specimen container supply apparatus comprising a container storing box 1 having an insertion port (top opening of the container; Fig. 1), and a bottom 1a with a tapered (slanted) surface creating a container collecting position in a lowest part thereof to collect a plurality of tube-type specimen containers A. The Yuyama apparatus also includes a container individually-sending mechanism 2 configured to lift up the specimen containers collected in the container collecting position one-by-one along one side wall 5 located close to the container collecting position. The apparatus has an outlet 5x formed in the one side wall to discharge the specimen containers outside the storing box lifted up by the container individually-sending mechanism, and a container carry-out mechanism including a carry-out conveyor 26 to automatically carry out the specimen containers discharged through the outlet.

The container individually-sending mechanism of Yuyama includes a lifting plate 2 driven up and down by a drive source (motor 12); the lifting plate has a top end with a tapered surface 7 descending toward an outside of the container storing box (Fig. 5). Note that the surface area of 7 allows for only one specimen container lying on a side thereof (i.e., no side-by-side containers), although multiple containers may be disposed end-to-end on the lifting plate. The claim language does not preclude the containers being disposed end-to-end on the lifting plate. Yuyama does not specifically teach the use of an auxiliary plate mounted on one side of the lifting plate such that the auxiliary plate is slidable up and down relative to the lifting plate. The auxiliary plate has a top end with a tapered surface that descends toward an outside of the container storing box, the top end of the auxiliary plate being flush with that of the lifting plate when the lifting plate descends and being located in a lower level than that of the lifting plate when the lifting plate ascends.

Miner also teaches an auxiliary plate C mounted on one side of the lifting plate such that the auxiliary plate is slidable up and down relative to the lifting plate (Figs. 1 and 3). The auxiliary plate of has a top end with a tapered surface that descends toward an outside of the container storing box, the top end of the auxiliary plate being flush with that of the lifting plate when the lifting plate descends and being located in a lower level than that of the lifting plate when the lifting plate ascends.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of Yuyama to include an auxiliary plate, as taught by Miner, in order to help move the containers through the outlet while preventing the outlet from becoming blocked by too many containers.

Miner does not teach the tapered surface of the lifting plate having space to place only one specimen container in a side-by-side manner. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of Miner so that the tapered surface of the lifting plate only has enough space to place one specimen container so that the outlet does not become jammed with too many containers. Furthermore, it has been held that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device, the dimensions are considered a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed device was significant, see MPEP 2144.04 and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yuyama (US Patent no. 6,138,868) in view of Miner (US Patent no. 488,084), as applied to claim 1 above, and further in view of Portyansky (US Patent no. 4,567,997).

The teachings of Yuyama and Miner have been summarized previously, *supra*. The combined system of Yuyama and Miner do not specifically disclosed the container storing box having a two-layer structure including a first and a second partition plate that are vertically opposed to each other. The first partition plate having a tapered surface that descends from one side to another side, and the second partition plate having a tapered surface that descends in a direction opposite to the tapered surface of the first

partition plate, and a path is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Portyansky teach a stick delivery mechanism (Fig. 1) comprising, *inter alia*, a container storing box 12 having a two-layer structure including a first partition plate 16 and a second partition plate 22, 24 that are angled downwardly with respect to a horizontal plane. The first partition plate having a tapered (slanted) surface that descends from one side to the other side, and the second partition plate having a tapered (slanted) surface that descends in a direction opposite to the tapered surface of the first partition plate, and a path 26 is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the combined system of Yuyama and Miner to include the specific partition configuration, as taught by Portyansky, in order to help prevent more than one container from being disposed through the outlet so as to prevent the outlet from becoming blocked by too many containers simultaneously flowing therethrough.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizuka (JP 2002-306952).

Ishizuka teaches an automatic tube-type specimen container supply apparatus comprising; a container storing box 1 having an insertion port (top opening of the container; Fig. 1), and a bottom with a tapered (slanted) surface creating a container collecting position in a lowest part thereof to collect a plurality of tube-type specimen

containers D. The Ishizuka apparatus also includes a container individually-sending mechanism 22 configured to lift up specimen containers collected in the container collecting position along one side wall 34 located approximate to the container collecting position. The apparatus has an outlet 34a formed in the one side wall to discharge the specimen containers outside the storing box lifted up by the container individually-sending mechanism, and a container carry-out mechanism including a chute 5, which acts as a conveyor since it automatically carries out the discharged specimen containers.

The container individually-sending mechanism of Ishizuka includes a lifting plate 22 driven up and down by a drive source (motor 23); the lifting plate has a top end with a tapered surface 22a descending toward the outside of the container storing box (Fig. 5). Ishizuka also teaches an auxiliary plate 21 mounted on one side of the lifting plate such that the auxiliary plate is slidable up and down relative to the lifting plate (Figs. 4a-d). The auxiliary plate of has a top end with a tapered surface that descends toward the outside of the container storing box, the top end of the auxiliary plate being flush with that of the lifting plate when the lifting plate descends (Fig. 4c) and being located in a lower level than that of the lifting plate when the lifting plate ascends (Fig. 4b).

Ishizuka does not teach the tapered surface of the lifting plate having space to place a single specimen container in a side-by-side manner. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of Ishizuka so that the tapered surface of the lifting plate only has enough space to place one specimen container in a side-by-side manner to prevent the outlet from becoming jammed with too many containers. Furthermore, it has

been held that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device, the dimensions are considered a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed device is significant, see MPEP 2144.04 and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizuka in view of Portyansky (US Patent no. 4,567,997).

The teachings of Ishizuka have been summarized previously, *supra*. Ishizuka does not specifically disclosed the container storing box having a two-layer structure including a first partition plate and a second partition plate that are vertically opposed to each other. The first partition plate having a tapered surface that descends from one side to the other side, and the second partition plate having a tapered surface that descends in a direction opposite to the tapered surface of the first partition plate, and a path is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Portyansky teach a stick delivery mechanism (Fig. 1) comprising, *inter alia*, a container storing box 12 having a two-layer structure including a first partition plate 16 and a second partition plate 22, 24 that are angled downwardly with respect to a horizontal plane. The first partition plate having a tapered (slanted) surface that descends from one side to another side, and the second partition plate having a tapered (slanted) surface that descends in a direction opposite to the tapered surface of the first

partition plate, and a path 26 is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of Ishizuka to include the partition configuration, as taught by Portyansky, in order to help prevent more than one container from disposal through the outlet so as to prevent the outlet from becoming blocked by too many containers simultaneously flowing therethrough.

Response to Arguments

9. Applicant's arguments filed July 30, 2007 have been fully considered but they are not persuasive.

With respect to the previous rejection of claims 1 and 2 (corresponds essentially to current claim 1) under 35 U.S.C. 103(a) as being unpatentable over Ishizuka (JP 2002-306952), Applicant argues that Ishizuka fails to teach the functional language of claim 1, which describes the lifting plate and the auxiliary plate being constructed such that the top end of the auxiliary plate is flush with that of the lifting plate when the lifting plate descends and is located in a lower level than that of the lifting plate when the lifting plate ascends.

The Examiner respectfully disagrees with Applicant's assertion. First, the Examiner contends that the auxiliary and lift plates of Ishizuka do, in fact, operate in the manner recited in claim 1. Specifically, the auxiliary plate has a top end with a tapered surface that descends toward the outside of the container storing box. The top end of the auxiliary plate is flush with that of the lifting plate when the lifting plate descends

(Fig. 4c) and located in a lower level than that of the lifting plate when the lifting plate ascends (Fig. 4b).

Assuming, *arguendo*, that the plates of Ishizuka did not operate in the exact manner set forth in claim 1, such a limitation is merely an intended use which the prior art would inherently be capable of doing, the only distinction between applicant's claims and the prior art is recited functional language. See *In re Ludtke*, 169 USQ 563 (CCPA 1971). Only structural language is determinative of the metes and bounds of a patent claim. Functional recitations, standing alone, while perhaps helpful in understanding the meaning of a claim and the invention that it represents, cannot be relied upon to distinguish over the prior art. An applicant must establish that what is expressly taught by the prior art does not function in the manner required by the claim.

Similarly, with respect to the previous rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Yuyama (US Patent no. 6,138,868) in view of Miner (US Patent no. 488,084), Applicant again argues that the auxiliary plate C and lifting plate D in Miner moves in contrast with the claimed invention.

Again, the Examiner respectfully disagrees that the auxiliary plate C and lifting plate D do not operate in the manner set forth in the apparatus claim 1. Specifically, The auxiliary plate of has a top end with a tapered surface that descends toward an outside of the container storing box. The top end of the auxiliary plate of Miner is flush with that of the lifting plate when the lifting plate descends (Fig. 3, Miner) and is located in a lower level than that of the lifting plate when the lifting plate ascends (Fig. 2, Miner). Nevertheless, assuming the plates of Miner did not operate in the exact manner described in the functional language of claim 1, such a limitation is merely an intended

use which the prior art would inherently be capable of doing, the only distinction between applicant's claims and the prior art is recited functional language. See *In re Ludtke*, 169 USQ 563 (CCPA 1971). Only structural language is determinative of the metes and bounds of a patent claim. Functional recitations, standing alone, while perhaps helpful in understanding the meaning of a claim and the invention that it represents, cannot be relied upon to distinguish over the prior art. An applicant must establish that what is expressly taught by the prior art does not function in the manner required by the claim.

Therefore, for the reasons delineated above, claims 1 and 3 remain rejected herein.

Conclusion

10. No claims allowed.
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1743

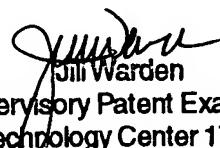
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright (f.k.a. Bex) whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pkw


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